

REMARKS

Favorable reconsideration of this application is respectfully requested, as amended. Claims 1 and 3-22 are currently pending.

Applicants gratefully acknowledge the courtesy of the telephone interview of December 8, 2006 extended by Examiners Arnold and Pryor to Applicants' representative, Eric W. Guttag. Following up on this December, 2006 telephone interview, and to facilitate advancement of the prosecution and potential allowance of the above application, Applicants have, in the current amendment, cancelled Claim 11, without prejudice or disclaimer. Applicants retain the right to pursue the subject matter of cancelled Claim 11 in a subsequently filed continuation application.

Further following up on this December 8, 2006 telephone interview, Amended Claim 21 to exclude tourmaline from the second group of naturally occurring elements. In addition and as was discussed at this December 8, 2006 telephone interview, new Claim 22 has been added which is similar to Claim 1, but does not include tourmaline in the second group of naturally occurring elements. Support new Claim 22 may be found in, for example, paragraphs [0012]-[0013] at page 5 of the present application.

Further discussion from this December 8, 2006 telephone interview as to why amended Claim 21 and new Claim 22 overcome the rejection of Claims 1, 3, 7-10, 16 and 18-21 (see page 7 of the Office Action) under 35 U.S.C. § 102(b) as anticipated by U.S. Patent 6,378,138 to Ridgely *et al.* (Ridgely *et al.* '138), as evidenced by the Wikipedia definition of tourmaline, as well as the rejection of Claims 1, 3, 7-10, 16 and 18-21 under 35 U.S.C. § 102(b) as anticipated by Untracht, O., Jewelry Concepts and Technology (Untracht), as evidenced by the Wikipedia definition of tourmaline, is presented below.

Applicants kindly acknowledge the statements at pages 2-3 of the Office Action that the following rejections have been withdrawn:

1. Claims 1-6 (now Claims 1, 3-6 and 21) under 35 U.S.C. § 101 as being directed to non-statutory subject matter.
2. Claims 1, 3-8, and 11 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 6,145,341 to Leong (Leong '341).
3. Claims 1, 11-13, and 15 under 35 U.S.C. § 102(b) as being anticipated by Derwent-Acc-No: 1990-140052 which abstracts CN 1033154 (Derwent 1990-140052).

4. Claims 1 and 13-15 under 35 U.S.C. § 102(b) as being anticipated by Derwent-Acc-No: 2000-148175 which abstracts CN 1235834 (Derwent 2000-148175).
5. Claims 1, 16, and 19-20 under 35 U.S.C. § 103(a) as being unpatentable over Derwent 1990-140052 which abstracts CN 1033154 (Derwent 1990-140052).
6. Claims 1, 7, 9 and 10 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,145,341 to Leong (Leong '341).
7. Claims 1 and 16-17 under 35 U.S.C. § 103(a) as being unpatentable over Derwent-Acc-No: 2000-148175 which abstracts CN 1235834 (Derwent 2000-148175).

A. Response to Rejection of Claims 1 and 3-21 under 35 U.S.C. § 112, First Paragraph

At pages 3-7 of the Office Action, Claims 1 and 3-21 have been rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the enable requirement. Specifically, the Office Action alleges that Claims 1 and 21, in reciting “a combination providing therapeutic benefit,” fails to provide information to one skilled in the art “to fully practice” the claimed invention “without undue experimentation.” For reasons discussed at the December 8, 2006 telephone interview and as are presented below, Applicants respectfully traverse this rejection of Claims 1 and 3-21, as amended and as currently presented, under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

In support of this rejection, the Office Action cites, but incorrectly and improperly applies, the following factors from *In re Wands*, 8 USPQ2d 1400 (Fed. Cir. 1988):

1. Scope and breadth of claims. The Office Actions alleges that specification merely discloses, without more, that “a naturally occurring element combination can provide or improve the physical energy, well-being and support of individuals and provide relief from various types of pains and aches such as muscle stiffness, headache, menstrual pain, sprain, inflammation, arthritis, carpal tunnel, bruises, broken bones and sports

injuries,” referring to paragraph [0008] at page 3 of the present application, and further alleges that “there is no evidence that the invention works as instantly claimed. But it is the Office Action which improperly puts the burden on Applicants to demonstrate that that “the invention works as instantly claimed.” The Office Action fails to point to any substantial evidence to support the alleged position that the claimed invention would not provide one or more of the therapeutic benefits described in paragraph [0008] at page 3 of the present application. See, e.g., *In re Gartside*, 203 F.3d 1305, 1315-16, 53 USPQ2d 1769 (Fed. Cir. 2000) (factual findings must be set aside if unsupported by substantial evidence). Accordingly, this allegation must be based on the Examiner’s personal knowledge. Applicants, therefore, respectfully request the Examiner to provide an affidavit/declaration under 37 CFR 1.104(d)(2) in support of this allegation which appears to be based on personal knowledge of the Examiner, and not what shown by any substantial evidence presented in the Office Action.

2. Nature of the invention. The Office Action merely alleges that the invention “is directed to an elemental combination for providing a therapeutic benefit.” But the Office Action never says or explains why this allegation causes the claimed invention not to be enabled.
3. Relative level of skill possessed by one of ordinary skill in the art. The Office Action alleges “that the relative level of skill possessed by one of ordinary skill in the art of medical research is relatively high, as a majority of lead investigators directing scientific research and development in this particular technological area possess an M.D. and/or a Ph.D. in a scientific discipline such as organic synthetic chemistry, medical chemistry, biochemistry, pharmacology, biology or the like.” But the Office Action never properly explains what the basis is for the alleged level of skill in the art. In fact, the Office Action fails to cite any substantial evidence to support this alleged level of skill in art. See, e.g., *In re Gartside*, 203 F.3d 1305, 1315-16, 53 USPQ2d 1769 (Fed. Cir. 2000) (factual findings must be set aside if unsupported by substantial evidence). Accordingly, this alleged level of skill in the art must be based on the Examiner’s personal

knowledge. Applicants therefore respectfully request the Examiner to provide an affidavit/declaration under 37 CFR 1.104(d)(2) in support of this alleged level of skill in the art which appears to be based on personal knowledge of the Examiner, and not what shown by any substantial evidence presented in the Office Action.

4. State of, or the amount of knowledge in, the prior art. The Office Action alleges that “the therapeutic value of crystals is controversial in the art and there are not a sufficient number of reports available identifying the uses of crystal therapy. But the Office Action only provides one citation in support of this allegation. The Office Action nowhere properly shows or demonstrates that what is alleged by this one citation is “generally accepted” by those skilled in this art. Put differently, the Office Action has failed to provide substantial evidence to refute the therapeutic benefit described in the present application for the claimed invention. See, e.g., *In re Gartside*, 203 F.3d 1305, 1315-16, 53 USPQ2d 1769 (Fed. Cir. 2000) (factual findings must be set aside if unsupported by substantial evidence).
5. Level or degree of predictability, or lack thereof, in the art. The Office Action alleges that “the safety and effectiveness of these techniques have not been thoroughly tested scientifically” and further alleges that “there is no evidence for this technique. But the Office Action again only provides one citation in support of this allegation. Once again, the Office Action nowhere properly demonstrates that what is alleged by this one citation is “generally accepted” by those skilled in this art. Put differently, the Office Action has again failed to provide substantial evidence to refute the therapeutic benefit described in the present application for the claimed invention. See, e.g., *In re Gartside*, 203 F.3d 1305, 1315-16, 53 USPQ2d 1769, (Fed. Cir. 2000) (factual findings must be set aside if unsupported by substantial evidence). In fact, the art cited at page 2 of the present application (Background of Invention Section), as well as that relied on in the Office Action in rejecting the instant Claims shows and demonstrates to the contrary, that therapeutic benefits alleged for the claimed invention are actually “generally accepted” by those skilled in this particular art. See

column 1, lines 53-58 of U.S. Patent 6,014,973 (Kaufman), issued January 18, 2000 (method of healing comprising combination of five healing elements secured by flexible strand for wearing on body for “safely and reliably heal[ing] bodily ailments including, but not limited to, aches and pains, inflammation, sprains, arthritis, muscle stiffness, carpal tunnel, and injuries”); column 2, lines 19-24 of U.S. Patent 6,143,946 (Docter), issued November 7, 2000 (therapeutic mat including relatively elastic substrate, hydrogel connected to substrate and plurality of microcrystals dispersed throughout hydrogel for “treating wounds as a result of ulceration, burns, abrasions, angina, carpal tunnel, broken bones, fractures, wounds and incisions, for example”); and column 1, lines 38-41 and column 2, line 31 through column 4, line 16 of U.S. Patent 6,378,138 (Ridgley et al), issued April 30, 2002 (stocking or hosiery that incorporates naturally occurring elements for “healing various bodily ailments”).

6. Amount of guidance or direction provided by the inventor. The Office Action alleges that Applicants “[are] required to provide in the specification additional guidance and direction with respect to how to use the claimed subject matter in order for the application to be enabled with respect to the full scope of the claimed invention.” But what the Office Action alleges or suggests is refuted by what is actually taught in the present application. The present application, in fact, provides sufficient “guidance” to practice the claimed invention, as in shown in, for example, paragraph [0013] at page 5 (describing what forms the claimed invention may take), paragraph [0014] at pages 5-6 (describing how the claimed invention may be worn or secured to the body, or the area or part of the body to be treated), paragraphs [0015]-[0016] at pages 6-7 (describing how the claimed invention may formulated for insertion, ingestion or application), paragraph [0017] at page 7 (describing how the claimed invention may be positioned for therapeutic treatment), and paragraph [0020] at pages 7-8 (describing how long the claimed invention should be positioned proximate to or in direct contact with the body to provide treatment benefits).

7. Presence or absence of working examples. The Office Action alleges that the “specification fails to provide any scientific data and working embodiments with respect to a combination providing the therapeutic benefit. But contrary to what is alleged or suggested in the Office Action, the above application does provide working examples, as illustrated in and described above with reference to paragraphs [0013]-[0017] and [0020] of the present application. Even assuming the above application did not have any working examples, there is no statutory requirement (*i.e.*, under 35 U.S.C. § 112, first paragraph) that there be any working examples in the specification. All that is required by 35 U.S.C. § 112, first paragraph, is that the specification teach one skilled in the art (not a layman, a patent examiner or a patent attorney/agent) how to practice the claimed invention. With regard to the question of working examples, neither the Patent Statutes, Rules of Practice nor case law require any working examples. In fact, the Office Action fails to cite to any Patent Statute, Practice Rule and/or case law that requires working examples to be present in the application.
8. Quantity of experimentation required to make and use the claimed invention based upon the content of the supporting disclosure. The Office Action alleges that Applicants have “not disclosed any working examples nor suggested the amount of material required in what ratios, and for what duration they must be applied/administered to the patient in order to achieve a therapeutic benefit,” including “how much of the composition is required to provide such a benefit if ingested,” “how does one of ordinary skill in the art know if an individual is in need of vibrational therapy, “how does one of ordinary skill in the art know which combination to place where next to the individual to provide a therapeutic benefit?” The Office Action then alleges that, as a result, “one of ordinary skill in the art would be required to conduct labor intensive trial and error experimentation with each and every combination in a myriad number of ratios of components for an unknown period of time, nor to mention the preferred route of administration such as oral, topical, or rectal, on patients suffering from, for example, pain in order

to ascertain if the combination had the desired therapeutic effect,” and further alleges that “one of ordinary skill in the art would have to conduct an undue amount of experimentation to reasonably and accurately determine whether the combination would provide a therapeutic benefit.” But as noted above, and contrary to what the Office Action alleges or suggests, and as shown in paragraphs [0013]-[0017] and [0020] of the present application, Applicants have provided sufficient guidance for one skilled in this art to practice the claimed invention without “undue experimentation.”

In conclusion, the Office Action alleges that “it is readily apparent from the from the aforementioned disclosure, in conjunction with a corresponding lack of scientific data and working embodiments regarding the therapeutic benefit of the combination, that one of ordinary skill in the art would therefore be required to conduct an undue amount of experimentation to reasonably and accurately extrapolate whether said combination would be therapeutically beneficial,” citing to *Genentech*, 108 F.3d 1366. But, for at least the reasons presented above, it is, in fact, the Office Action, which has failed to provide any substantial evidence or any appropriate basis to support the rejection of Claims 1 and 3-21 for lack of enablement. Accordingly, Applicants respectfully request that this rejection of Claims 1 and 3-21 under 35 U.S.C. § 112, first paragraph, for lack of enablement be withdrawn.

B. Response to Rejection of Claims 1, 3, 7-10, 16 and 18-21 under 35 U.S.C. § 102(b) as Anticipated by Ridgely *et al.* ‘138

At page 7 of the Office Action, Claims 1, 3, 7-10, 16 and 18-21 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 6,378,138 to Ridgely *et al.* (Ridgely *et al.* ‘138), as evidenced by the Wikipedia definition of tourmaline.

Briefly, Ridgely *et al.* ‘138 discloses stocking or hosiery that incorporates naturally occurring elements for healing various bodily ailments. These naturally occurring elements may include Alexandrite, Amazonite, amber, Amethyst, Aquamarine, Aventurine, Azurite, Bloodstone, Calcite, Carelian, Celestite, Chrysoprase, Citrine, Diamond, Dioptase, Emerald, Fluorite, Garnet, Gold, Hematite, Herkimer Diamond, Jade,

Jasper, Kunzite Pink, Lapis Lazuli, Lepidolite, Malachite, Moonstone, Obsidian, Onyx, Opal, Peridot, Pyrite, Quartz Crystal, Rhodochrosite, Rhodonite, Rose Quartz, Ruby, Rutilated Quartz, Smoky Quartz, Sugilite, Sodalite, Sapphire, Silver, tiger Eye, Topaz, Tourmaline, Turquoise, and Zircon. See column 2, lines 14-28.

Applicants respectfully traverse this rejection of Claims 1, 3, 7-10, 16 and 18-21, as amended and as currently presented, as anticipated by Ridgely, *et al.* '318, even in view of the Wikipedia definition of tourmaline. Claim 1 recites a combination comprising: (1) at least one naturally occurring element selected from a first group consisting of charoite, rubellite, rubellite with quartz, and rhyolite; and (2) at least one naturally occurring element selected from a second group consisting of alexandrite, amazonite, amber, amethyst, aquamarine, aventurine, azurite, bloodstone, calcite, carelian, celestite, chrysoprase, citrine, copper, diamond, diopase, emerald, fluorite, garnet, gold, hematite, Herkimer diamond, jade, jasper, kunzite pink, lapis lazuli, lepidolite, malachite, manganese, moonstone, moss agate, obsidian, onyx, opal, peridot, pyrite, quartz crystal, rhodochrosite, rhodonite, rose quartz, ruby, rutilated quartz, smoky quartz, sugilite, sodalite, sapphire, silver, tiger eye, topaz, tourmaline, turquoise and zircon. (Emphasis added.)

By contrast and as was pointed out at the December 8, 2006 telephone interview, Ridgely *et al.* '138 does not teach or suggest at least one naturally occurring element from the first group of Claim 1, with at least one naturally occurring element from the second group of Claim 1. In fact, Ridgely *et al.* '138 does not teach any of the elements from the first group of Claim 1, including rubellite.

Instead, the Office Action alleges that "red and pink tourmaline is known as rubellite," citing the Wikipedia definition of "tourmaline" at page 2 under "other names for tourmaline." But, as was pointed out at the December 8, 2006 telephone interview, the Office Action has also previously cited other art suggesting that "tourmaline" and "rubellite" are entirely different gem stones. See column 4, line 51, of U.S. Patent 6,145,341 (Leong). See also column 2, lines 33-35 of U.S. Patent 4,857,306 (Roller). In other words, the alleged art does not conclusively show, as required by 35 U.S.C. § 102(b), that "tourmaline" and "rubellite" are the same or equivalent terms based on what is fairly disclosed by Ridgely *et al.* '138. As was also pointed out at the December 8, 2006 telephone interview, the Wikipedia is not checked for the accuracy of the information

provided, and therefore does not necessarily reflect what is known by those skilled in this art with regard to the alleged equivalency of “tourmaline” and “rubellite.”

In fact, as was pointed out at the December 8, 2006 telephone interview, the Office Action has misapplied the requirements MPEP § 2131.01 as to when it is proper to use multiple references in rejecting claims under 35 U.S.C. § 102(b) where the secondary reference (*i.e.*, the Wikipedia definition of “red” and “pink” tourmaline which, as noted above, is not necessarily reliable) is being used to show an allegedly inherent characteristic of the primary reference (*i.e.*, “tourmaline” taught in Ridgely *et al.* ‘138). See *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991) which is cited to in MPEP § 2131.01: “To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” (Emphasis added.) As was pointed out at the December 8, 2006 telephone interview, and contrary to the holding in *Continental Can*, the Office Action has failed to establish that it is “clear that the missing descriptive matter” (*i.e.*, “red” and “pink” tourmaline is the same or equivalent to rubellite) “is necessarily present in the thing described in the reference” (*i.e.*, tourmaline taught in Ridgely *et al.* ‘138), and “that it would be so recognized by persons of ordinary skill.”

As was pointed out at the December 8, 2006 telephone interview, Claim 21, as amended, is distinguishable over Ridgely *et al.* ‘138 for a different reason. As amended, Claim 21 excludes tourmaline from the second group of naturally occurring elements. By contrast, Ridgely *et al.* ‘138 does not disclose compositions comprising combinations of the first group of naturally occurring elements with the amended second group of naturally occurring elements according to amended Claim 21.

As was further pointed out at the December 8, 2006 telephone interview, new Claim 22 is also distinguishable over Ridgely *et al.* ‘138 for a different reason. As presented, Claim 22 recites that at least one naturally occurring element selected from a first group consisting of charoite, rubellite, rubellite with quartz, and rhyolite, in combination with at least one naturally occurring element selected from a second group consisting of alexandrite, amazonite, amber, amethyst, aquamarine, aventurine, azurite, bloodstone, calcite, carnelian, celestite, chrysoprase, citrine, copper, diamond, diopase,

emerald, fluorite, garnet, gold, hematite, Herkimer diamond, jade, jasper, kunzite pink, lapis lazuli, lepidolite, malachite, manganese, moonstone, moss agate, obsidian, onyx, opal, peridot, pyrite, quartz crystal, rhodochrosite, rhodonite, rose quartz, ruby, rutilated quartz, smoky quartz, sugilite, sodalite, sapphire, silver, tiger eye, topaz, tourmaline, turquoise and zircon, *i.e.*, tourmaline is not included. By contrast, Ridgely *et al.* '138 does not disclose any of the second group of naturally occurring elements in combination with the first group of naturally occurring elements according to new Claim 22.

For at least the foregoing reasons, Claims 1, 3, 7-10, 16 and 18-21, as amended or as currently presented, are novel and unobvious over Ridgely *et al.* '138.

C. Response to Rejection of Claims 1, 7, 16 and 18-21 under 35 U.S.C. § 102(b) as Anticipated by Untracht

At page 7 of the Office Action, Claims 1, 3, 7-10, 16 and 18-21 have again been rejected under 35 U.S.C. § 102(b) as being anticipated by Untracht, O., Jewelry Concepts and Technology (Untracht), as evidenced by the Wikipedia definition of tourmaline.

Briefly, page 510 of Untracht discloses in photograph 11-55 a symmetrical necklace in sterling silver, with 19 tourmalines. Page 601 of Untracht discloses in photograph 11-55 a gold ring with a flat-topped barrel-shaped tourmaline set in divided bezel. .

Applicants respectfully traverse this rejection of Claims 1, 7, 16 and 18-21, as amended or as currently presented, as anticipated by Untracht, even in view of the Wikipedia definition of tourmaline. Claim 1 recites a combination comprising: (1) at least one naturally occurring element selected from a first group consisting of charoite, rubellite, rubellite with quartz, and rhyolite; and (2) at least one naturally occurring element selected from a second group consisting of alexandrite, amazonite, amber, amethyst, aquamarine, aventurine, azurite, bloodstone, calcite, carelian, celestite, chrysoprase, citrine, copper, diamond, diopase, emerald, fluorite, garnet, gold, hematite, Herkimer diamond, jade, jasper, kunzite pink, lapis lazuli, lepidolite, malachite, manganese, moonstone, moss agate, obsidian, onyx, opal, peridot, pyrite, quartz crystal, rhodochrosite, rhodonite, rose quartz, ruby, rutilated quartz, smoky quartz, sugilite, sodalite, sapphire, silver, tiger eye, topaz, tourmaline, turquoise and zircon. (Emphasis added.)

By contrast, and as was pointed out at the December 8, 2006 telephone interview, Untracht does not teach or suggest at least one naturally occurring element from the first group of Claim 1, with at least one naturally occurring element from the second group of Claim 1. In fact, Untracht does not teach any of the elements from the first group of Claim 1, including rubellite.

Instead, the Office Action again alleges that “red and pink tourmaline is known as rubellite,” citing the Wikipedia definition of “tourmaline” at page 2 under “other names for tourmaline.” But as pointed out above, and as was also pointed out at the December 8, 2006 telephone interview, the Office Action has also previously cited other art suggesting that “tourmaline” and “rubellite” are entirely different gem stones. See column 4, line 51, of U.S. Patent 6,145,341 (Leong). See also column 2, lines 33-35 of U.S. Patent 4,857,306 (Roller). In other words, the alleged art again does not conclusively show, as required by 35 U.S.C. § 102(b), “tourmaline” and “rubellite” are the same or equivalent terms as tourmaline disclosed by Untracht. As was also pointed out at the December 8, 2006 telephone interview, the Wikipedia is not checked for the accuracy of the information provided, and therefore does not necessarily reflect what is known by those skilled in this art with regard to the alleged equivalency of “tourmaline” and “rubellite.”

In fact, and as was pointed out at the December 8, 2006 telephone interview, the Office Action has again misapplied the requirements of MPEP § 2131.01 as to when it is proper to use multiple references in rejecting claims under 35 U.S.C. § 102(b) where the secondary reference (*i.e.*, the Wikipedia definition of “red” and “pink” tourmaline which, as noted above, is not necessarily reliable) is being used to show an allegedly inherent characteristic of the primary reference (*i.e.*, “tourmaline” taught in Untracht). See *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991) which is cited to in MPEP § 2131.01: “To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” (Emphasis added.) As was pointed out at the December 8, 2006 telephone interview, and contrary to the holding in *Continental Can*, the Office Action has failed to establish that it is “clear that the missing descriptive matter” (*i.e.*, “red” and “pink” tourmaline is the same or equivalent to rubellite)

“is necessarily present in the thing described in the reference” (*i.e.*, tourmaline taught in Untracht), and “that it would be so recognized by persons of ordinary skill.”

As was pointed out at the December 8, 2006 telephone interview, Claim 21, as amended, is distinguishable over Untracht for a different reason. As amended, Claim 21 excludes tourmaline from the second group of naturally occurring elements. Untracht does not disclose compositions comprising combinations of the first group of naturally occurring elements with the amended second group of naturally occurring elements according to amended Claim 21.

As was further pointed out at the December 8, 2006 telephone interview, new Claim 22 is also distinguishable over Untracht for a different reason. As presented, Claim 22 recites at least one naturally occurring element selected from a first group consisting of charoite, rubellite, rubellite with quartz, and rhyolite, in combination with at least one naturally occurring element selected from a second group consisting of alexandrite, amazonite, amber, amethyst, aquamarine, aventurine, azurite, bloodstone, calcite, carelian, celestite, chrysoprase, citrine, copper, diamond, diopase, emerald, fluorite, garnet, gold, hematite, Herkimer diamond, jade, jasper, kunzite pink, lapis lazuli, lepidolite, malachite, manganese, moonstone, moss agate, obsidian, onyx, opal, peridot, pyrite, quartz crystal, rhodochrosite, rhodonite, rose quartz, ruby, rutilated quartz, smoky quartz, sugilite, sodalite, sapphire, silver, tiger eye, topaz, tourmaline, turquoise and zircon, *i.e.*, tourmaline is not included. By contrast, Untracht does not disclose any of the second group of naturally occurring elements in combination with the first group of naturally occurring elements according to new Claim 22..

For at least the foregoing reasons, Claims 1, 7, 16 and 18-21, as amended or as currently presented, are novel and unobvious over Untracht.

D. Response to Rejection of Claims 1, 3-11 and 19-21 under 35 U.S.C. § 103(a) as Unpatentable over Untracht

At pages 9-11 of the Office Action, Claims 1, 3-11 and 19-21 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Untracht.

The Office Action concedes that Untracht does not teach: (1) the specific amount of the naturally occurring elements according to Claims 4-6; or (2) the devices (*e.g.*, strap, clothing, furniture, *etc.*) according to Claims 7-10. Instead, the Office Action alleges that

it would have been obvious “to make naturally occurring element combinations in the amounts of from 1 to 10 parts and the narrower range of about 1 to about 2 parts and make devices associated with the combination which are a strap, clothing or furniture including the combination and produce the instant invention.” The alleged “motivation” provided by the Office Action is that “because in the art of making jewelry one of ordinary skill in the art is inclined to mix and match various naturally occurring elements to create various combinations as shown in Untracht,” that “one of ordinary skill in the art can mix and match any naturally occurring elements in any ratio to produce such combinations,” and that “adornment of straps, clothing and furniture is a reasonable extension of the artisan to decorate items for market.”

Applicants respectfully traverse this rejection of Claims 1, 3-11 and 19-21, as amended and as currently presented, over Untracht for reasons previously presented as to why Claims 1, 7, 10 and 19-21 are novel and unobvious over Untracht, and for the following additional reasons. With regard to Claims 4-6 and 7-10, this rejection is *prima facie* improper because the Office Action has failed to properly allege a *prima facie* case of obviousness. As set forth in MPEP § 706.02(j): “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, ***there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings*** Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The ***teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on Appellant’s disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See also MPEP § 2143- §2143.03 for decisions pertinent to each of these criteria (emphasis added).***”

In fact, and as conceded by the Office Action, Untracht does not teach or suggest all of the features of Claims 4-6 or Claims 7-10. In other words, the rejection of these Claims fails to satisfy at least one of the criteria (prior art reference, or references when combined, must teach or suggest all the claim limitations) set forth in MPEP § 706.02(j) for a *prima facie* case of obviousness. In fact, the Office Action fails to identify where these admittedly absent claim features are shown in the art, in violation of 37 CFR 1.104(c)(2). Instead, these allegations regarding Claims 4-6 and Claims 7-10 appear to be

based on the Examiner's personal knowledge. Accordingly, if the Examiner wishes to persist in these allegations regarding Claims 4-6 and Claims 7-10, Applicants respectfully request that he provide an affidavit/declaration under 37 CFR 1.104(d)(2) because these allegation appear to be based on personal knowledge, and not what is taught by the art relied on in the Office Action.

For the foregoing reasons, Claims 1, 3-11 and 19-21, as amended or as currently presented, are unobvious over Untracht.

E. Response to Rejection of Claims 1 and 11-18 under 35 U.S.C. § 103(a) as Unpatentable over Phybiosis Medicinal Clay, in view of Ridgely *et al.* '138 and as Evidenced by the Wikipedia Definition of Tourmaline

At pages 12-14 of the Office Action, Claims 1 and 11-18 have been rejected under 35 U.S.C. § 103(a) as unpatentable over Phybiosis Medicinal Clay Technical Specifications 1999 (Phybiosis Medicinal Clay), in view of Ridgely *et al.* '138, and as evidenced by the Wikipedia definition of tourmaline.

Briefly, Phybiosis Medicinal Clay discloses a variety of medicinal clays, including yellow kaolin allegedly high in quartz content.

The Office Action concedes that Phybiosis Medicinal Clay does not teach the combination of Claim 12 that is a coating or paint, the combination of Claim 13 that is an ingestible composition, the combination of Claim 14 that is a beverage, the combination of Claim 15 that is a composition in the form of a source of water for drinking or bathing, the method of Claim 16 where the combination is used to treat an individual in need of vibrational therapy, the method of Claim 17 where the combination is ingested, or the method of Claim 18 where the combination is worn on the body of the user. Instead, the Office Action alleges that it would have been obvious "to include the healing crystal combination taught by [Ridgely *et al.* '138] in the composition of Phybiosis Medicinal Clay, such as beverages, baths, and coatings, and produce the instant invention and to treat an individual with the composition." The alleged "motivation" for this combining of Ridgely *et al.* '138 with Phybiosis Medicinal Clay is "to make an enhanced healing composition with possible synergistic effects of the materials."

Applicants respectfully traverse this rejection of Claims 1 and 11-18, as amended or as currently presented, over Phybiosis Medicinal Clay, even in view of Ridgely *et al.*

‘138 or as evidenced by the Wikipedia definition of tourmaline, for reasons previously presented as to why amended Claims 1, 16 and 18 are novel and unobvious over Ridgley et al. ‘138, even as evidenced by the Wikipedia definition of tourmaline, and for the following additional reasons. This rejection is *prima facie* improper because the Office Action has failed to state where the alleged “motivation” to combine Ridgley et al. ‘138 with Phybiosis Medicinal Clay is shown in the art relied on. In fact, the Office Action fails to show where this alleged “motivation” to combine Ridgley et al. ‘138 with Phybiosis Medicinal Clay comes from at all. As held by the Federal Circuit in *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002), specific reasons must be shown in the art suggesting a combination of references. See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“[P]articular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.”).

In other words, these allegations regarding the “motivation” to combine Ridgley et al. ‘138 with Phybiosis Medicinal Clay are nothing more than unsupported speculation which is not taught at all by any of the art relied on in the Office Action. Instead, these allegations regarding the “motivation” to combine Ridgley et al. ‘138 with Phybiosis Medicinal Clay appear to be based on the Examiner’s personal knowledge. Accordingly, if the Examiner wishes to persist in this allegation regarding the “motivation” to combine Ridgley et al. ‘138 with Phybiosis Medicinal Clay, Applicants respectfully request that he provide an affidavit/declaration under 37 CFR 1.104(d)(2) because this allegation appears to be based on personal knowledge, and not what is taught by the art relied on in the Office Action.

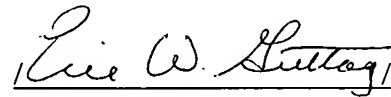
For at least the foregoing reasons, Claims 1 and 11-18, as amended or as currently presented, are unobvious over Phybiosis Medicinal Clay, even in view of Ridgely et al. ‘138, and even as evidenced by the Wikipedia definition of tourmaline.

F. Conclusion

Claims 1 and 3-22, as amended or as currently presented, comply with the enablement requirement under 35 U.S.C. § 112, first paragraph. Claims 1 and 3-22, as amended or as currently presented, are also novel and unobvious over the art relied on in the Office Action. Accordingly, Claims 1 and 3-22, as amended or as currently presented, should now be in now condition for allowance.

If the Examiner has any questions or concerns regarding the present response, the Examiner is invited to contact Eric W. Gutttag at 513-856-7272.

Respectfully submitted,



Eric W. Gutttag
Reg. No. 28,853
Customer No. 22,506

JAGTIANI + GUTTAG
Democracy Square Business Center
10363-A Democracy Lane
Fairfax, Virginia 22030
703-591-2664

January 17, 2007